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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,999

10/01/2004

Jun-ichi Kawakami

3010 USOP

3369

21874

7590

08/21/2008

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/500,999	<b>Applicant(s)</b> KAWAKAMI ET AL.	
	<b>Examiner</b> Laura L. Stockton, Ph.D.	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on May 29, 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-25 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-25 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

**Claims 22-25 and 30 are pending in the application.**

***Election/Restrictions***

Applicant's election with traverse of Group IV (Claims 22-25 and 30 - drawn to a crystal) in the reply filed on July 19, 2007 was acknowledged in the previous Office Action. The requirement was deemed proper and therefore made FINAL in the previous Office Action.

Claims 1-21, 26-29 and 31-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 19, 2007. Claims 1-21, 26-29 and 31-49 have been cancelled per the amendment filed May 29, 2008.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 22-25 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Dekker et al. {Organometallics, (1984), 3(9), pages 1403-1407}.

Dekker et al. disclose the ethyl ester of bromoacetic acid in dimeric form. See the entire document, especially the abstract on page 1403, Table II in the second column on page 1404, and the "Discussion" on page 1406 in column 1 and column 2, equilibria (2) on line 3.

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***Response to Arguments***

Applicant's arguments filed January 7, 2008 have been fully considered. Applicant argues that: (1) Dekker et al. is not sufficient to constitute an anticipating disclosure of the ethyl bromozincacetate **crystals** of the instant claimed invention; (2) there is no disclosure in Dekker et al. of the ethyl ester to which tetrahydrofuran (THF) is coordinated as recited in the claim language of claim 22 and claim 30; and (3) it is clear that ethyl reagent did not crystallize and that Dekker et al. was not able to obtain crystals of ethyl bromozincacetate according to the present invention.

All of Applicant's arguments have been considered but have not been found persuasive. Under the section "Preparation of the Reagents" (page 1404, column 1, first full paragraph), Dekker et al. disclose the process in which the reagents (i.e., the ethyl reagent) are formed and isolated in solid form. On page 1404 in

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column 2 , the last sentence before "Results", Dekker et al. disclose the reference, instrumentation, and program used for crystal structure determination. On page 1404 in column 2, under "Results", Dekker et al. state the following:

"A notable shortcoming in all studies of the Reformatsky reagent reported so far is the absence of (molecular) association measurements. It is to be expected that in all but the most polar solvents, the reagent, no matter what its structure really is, will be associated into dimers or higher associates in order to reach coordination saturation of the zinc. Therefore, we have employed molecular weight measurements to determine the degree of association of the Reformatsky reagents derived from both the ethyl and the tert-butyl ester of bromoacetic acid."

Further, in regard to the degree of association data in Table II on page 1404 (top of column 2), Dekker et al. state "It appears that the normal mode of association of the reagent is dimeric" (page 1405,

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column 1, first full paragraph). Additionally, the "Discussion" on page 1406 in column 1 and column 2, equilibria (2) on line 3 further support the disclosure of the instant claimed compound. Note equilibria (2) has a "R" variable in the formula wherein R represents ethyl or *t*-Bu (see Table II on page 1404 at the top of column 2). Hence, Dekker et al. disclose the ethyl ester of bromoacetic acid in dimeric form. For all the reasons given above, the rejection is deemed proper and therefore, the rejection is maintained.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on



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(571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/  
Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

August 22, 2008